

**Appl. No. 10/656,021**  
**Amdt. dated September 6, 2005**  
**Reply to Office action of May 6, 2005**

### **REMARKS/ARGUMENTS**

Applicant received the Office action of May 6, 2005, in which the Examiner: (1) provisionally rejected claims 2, 4-5, and 17-19 under 35 U.S.C. § 101 for obviousness-type double patenting in light of copending Application Serial No. 10/351,188; (2) provisionally rejected claim 3 for obviousness-type double patenting in light of copending Application Serial No. 10/351,188 in view of U.S. Patent No. 6,815,679 to *Azuma et al.*; (3) provisionally rejected claim 3 for obviousness-type double patenting in light of copending Application Serial No. 10/351,188 in view of U.S. Patent No. 6,682,810 to *Jones et al.*; (4) provisionally rejected claims 2, 4-5, and 17-19 under 35 U.S.C. § 102(e); (5) provisionally rejected claim 3 as obvious in light of copending Application Serial No. 10/351,188 in view of U.S. Patent No. 6,815,679 to *Azuma et al.*; (6) provisionally rejected claim 3 as obvious in light of copending Application Serial No. 10/351,188 in view of U.S. Patent No. 6,682,810 to *Jones et al.*; and (7) indicated that claims 6-16 would be permitted to be rejoined with claims 2-5 when 2-5 are allowable provided that claims 6-16 must contain all of the limitations of at least claim 2. Applicant files the instant amendment and response.

#### **I. NON-STATUTORY DOUBLE PATENTING**

The Examiner has rejected claims 2, 4-5, and 17-19 for obviousness type double patenting over copending Application Serial No. 10/351,188 ("the '188 Application"). The '188 is commonly owned with the instant application. Applicant will file a terminal disclaimer in the event Application Serial No. 10/351,188 issues as a patent. At such time, the terminal disclaimer will obviate this rejection.

**Appl. No. 10/656,021**  
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## **II. NON-STATUTORY DOUBLE PATENTING**

The Examiner has provisionally rejected claim 3 based on obviousness-type double patenting over the '188 Application combined with the '679 Patent to *Azuma et al.* The '188 Application is commonly owned with the instant application. If the '188 Application issues as a U.S. Patent, Applicant will file a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). At such time, the terminal disclaimer will obviate this rejection.

## **III. NON-STATUTORY DOUBLE PATENTING**

The Examiner has provisionally rejected claim 3 based on obviousness-type double patenting over the '188 Application combined with U.S. Patent No. 6,682,810 to *Jones et al.* The '188 Application is commonly owned with the instant application. If the '188 Application issues as a U.S. Patent, Applicant will file a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). At such time, the terminal disclaimer will obviate this rejection.

## **IV. § 102(E) REJECTION OVER THE '188 APPLICATION**

The Examiner has provisionally rejected claims 2, 4-5, and 17-19 under 35 U.S.C. § 102(e) as being anticipated by the '188 Application. Applicant has submitted a Declaration under 37 C.F.R. § 1.132 stating that "[a]ny feature or aspect of the presently claimed invention that is disclosed but not claimed in copending application Serial No. 10/351,188 was derived from the inventor of the present application." See also MPEP § 2136.05. Thus, Applicant respectfully requests withdrawal of this rejection and allowance of these claims.

## **V. § 103(A) REJECTION OVER THE '188 APPLICATION COMBINED WITH THE '679 PATENT**

The Examiner has rejected claim 3 as obvious over the '188 Application combined with the '679 Patent. However, the '188 Application is not available as § 103 prior art. Section 103(c) states in relevant part,

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Emphasis added).

**Appl. No. 10/656,021**  
**Amdt. dated September 6, 2005**  
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At the time the present application was filed, the '188 Application and the present application were both owned by the Hewlett-Packard Company. A Declaration under 37 C.F.R. § 1.130 in support of this assertion accompanies this response. Thus, under 103(c), the '188 Patent is not available in an obviousness rejection of the current application. For at least this reason, claim 3 is not obvious in light of the '188 Application combined with the '679 Patent.

**VI. § 103(A) REJECTION OVER THE '188 APPLICATION COMBINED WITH THE '810 PATENT**

The Examiner has rejected claim 3 as obvious over the '188 Application combined with the '810 Patent to *Jones et al.* However, the '188 Application is not available as § 103 prior art. Section 103(c) states in relevant part,

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Emphasis added).

At the time the present application was filed, the '188 Application and the present application were both owned by the Hewlett-Packard Company. A Declaration under 37 C.F.R. § 1.130 in support of this assertion accompanies this response. Thus, under 103(c), the '188 Patent is not available in an obviousness rejection of the current application. For at least this reason, claim 3 is not obvious in light of the '188 Application combined with the '810 Patent.

**VII. CONCLUSION**

Applicant believes he has fully responded to the Office action of May 6, 2005. Applicant respectfully requests that the Examiner reconsider his rejections and issue a Notice of Allowance in this case.

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary

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to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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